

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Anthony G. Macaluso	Art Unit:	2617
Serial No.:	10/809,922	Examiner:	Matthew C. Sams
Filed:	March 24, 2004	Conf. No.:	6755
Title:	ADVERTISING ON MOBILE DEVICES		

**Mail Stop Appeal**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program and 07 February 2006 - Extension of the Pilot Pre-Appeal Brief Conference program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal and factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-4, 6, 7, 17, 21 and 34-36 are pending with claims 1, 17, 26 and 34 being independent. In the Office Action dated October 8, 2008, the Office rejected claims 1-4 and 6, 7, 17, 21 and 34-36 under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,665,533 to Sakoda ("Sakoda") in view of U.S. Patent Application Publication No. 2003/0179229 to Van Erlach ("Van Erlach"). In addition, the Office rejected claims 8-13, 16, 18-20, 26-33 and 37-39 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sakoda in view of Van Erlach and further in view of U.S. Patent Application Publication No. 2002/0166127 to Hamano ("Hamano"). The Office rejected claims 5 and 22-24 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sakoda in view of Van Erlach and further in view of U.S. Patent Application Publication No. 2005/0131837 to Sanctis et al. ("Sanctis"). The Office rejected claims 14-15 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sakoda in view of Van Erlach and further in view of U.S. Patent No. 5,913,040 to Rakavy ("Rakavy"). Further, the Office rejected claim 25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sakoda in view of Van Erlach and further in view of U.S. Patent Application Publication No. 2002/0128908 to Levin ("Levin").

**Final Office Action of October 8, 2008 amounts to clear error for failing to present a *prima facie* case of obviousness.**

Appellant respectfully submits that the Final Office Action of October 8, 2008 fails to present a *prima facie* case of obviousness required under 35 U.S.C. § 103 because the rejections are fatally flawed at least for relying on a mischaracterization of the claims. For example, the Office misreads claim 1, which recites in part, “selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.”

As described in the previous response, in one aspect, the present application is directed to selecting a stored advertisement to present on a mobile device. The stored advertisement is selected based on a comparison of a determined time required to complete a wireless communication against a set threshold time. If the determined time is longer than a threshold time, an appropriate stored advertisement is selected and presented on the mobile device.

The Office continues to allege that Van Erlach teaches the claimed features at issue because Van Erlach describes a “selection criteria in determining which ad to show [] based on the amount of time available in the time slot” and an “ability to compress or alternatively decompress ads so that they can be made to fit into the available time slot.” (See Final Office Action Dated October 8, 2008 at page 2. Internal quotations removed.) The Office further contends that “the examiner views Van Erlach’s time slot to equating to the threshold time and the ability to compress or decompress the ad to fit and fill the time slot as equating to the “determined time.” (See *id.* Internal quotations removed.) However, this is an egregious mischaracterization of claim 1 and thus clear error on the part of the Office.

For example, claim 1 expressly requires “determining a time required to complete the wireless communication.” Thus, the determined time in claim 1 is the actual time required to complete the wireless communication involving a mobile device, such as downloading a file to the mobile device. In contrast, Van Erlach teaches compressing or decompressing an ad to fit into a time slot. Compressing or decompressing an ad has nothing to do with the claimed act of determining a time required to complete the wireless communication involving a mobile device. Thus, the ability to compress or decompress the ad to fit and fill the time slot in Van Erlach cannot reasonably be construed as the claimed “determining a time.”

In addition, claim 1 recites in part “selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.” (Emphasis added.) In claim 1, the time required to complete the wireless communication, such as downloading a file, is determined and that time is compared to a threshold time. Only if that determined time is longer than the threshold time, is an advertisement selected.

In contrast to claim 1, Van Erlach teaches selecting an ad to fit in an open time slot. (See, Van Erlach at paragraph [0011].) The ads are selected in Van Erlach based on information obtained from the biometric data of each user, and the selected ads are “fit” into the ad slots using “digital ad compression and decompression engines.” Because the ads in Van Erlach are already selected before compressing/decompressing the ads, it is unreasonable to conclude that the ads in Van Erlach are selected based on the time slot. Also, because the already selected ads are compressed/decompressed to **fit** the time slot, it is equally unreasonable to conclude that the ads in Van Erlach are selected based on the time slot. The Office’s position is analogous to an illogical assertion that a square block is selected based on a round hole because the square block could be carved to fit the round hole. Thus, it is unreasonable to construe the time slot in Van Erlach as the claimed “threshold time.”

Further, it is irrelevant whether the time slot in Van Erlach can reasonably be construed as the claimed threshold time. Claim 1 requires “selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.” This condition is used to make sure there will be enough time to show an advertisement on the mobile device. For example, if the time to download a file (the claimed time required to complete a wireless communication) is too short (not longer than a threshold time), then it is not feasible to present an advertisement on the mobile device.

For the Office’s claim construction to be valid, the Office must show that Van Erlach selects an ad if the “ability to compress or decompress the ad to fit the time slot” is longer than the “time slot.” This is not only incomprehensible, but technically illogical and untenable.

This goes to show that the pending rejections are based on mischaracterizations of the claimed features that lead to incomprehensible claim interpretation and erroneous results.

For at least these reasons, claim 1 is allowable over the proposed combination of Sakoda and Van Erlach. Claims 2-4, 6, 7, 17, 21 and 34-36 are allowable for at least the same reasons.

Claims 8-13, 16, 18-20, 26-33 and 37-39 depend from claims 1, 17 and 34, and are patentable over the proposed combination of Sakoda and Van Erlach for at least reasons similar to claims 1, 17 and 34 above. The addition of Hamano fails to cure the deficiencies of Sakoda and Van Erlach. In contrast to the claimed features, Hamano teaches displaying advertisements during “boot up” or “wake up” process. (See, e.g., Hamano at paragraphs [0030], [0035] and [0037].) The boot up and wake up process in Hamano are not related to any wireless communication and thus the ads in Hamano are not displayed “during at least a portion of the wireless communication....” Also, the boot up process in Hamano does not include “wherein the advertising application on a mobile device presents the new advertisement during the delay **if the delay is longer than a threshold time.**”

Claims 5 and 22-24 depend from claims 1 and 17, and are allowable over the proposed combination of Sakoda and Van Erlach for at least the same reasons. The addition of Sanctis fails to alleviate the deficiencies of Sakoda and Van Erlach. As described in the reply dated June 20, 2008, Sanctis is directed to sending to a mobile device a mobile alert message that the user must acknowledge and manually read in order to view a message related to the alert. (See Sanctis, ¶¶ [0042]-[0044].) The system in Sanctis does not store a plurality of advertisements and does not select one of the stored advertisements to present to the mobile device **if the delay is longer than a threshold time.** Thus, even if theoretically combinable, which is not conceded, the proposed combination of Sakoda, Erlach and Sanctis fails to teach or suggest at least the claimed “selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.”

Claims 14-15 depend from claim 1 and are allowable over the proposed combination of Sakoda and Van Erlach for at least the same reasons. The addition of Rakavy fails to alleviate the deficiencies of Sakoda and Van Erlach. In contrast to claims 14-15, Rakavy teaches “selecting advertisements and other information from a computer network database **based on user-defined preferences...**” (See Rakavy at abstract.) Because the ads in Rakavy are selected based on user-defined preferences, Rakavy does not teach or suggest “selecting one of presenting the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.”

Claim 25 depends from claim 17 and is allowable over the proposed combination of Sakoda and Van Erlach for at least the same reasons. The addition of Levin fails to cure the deficiencies of Sakoda and Van Erlach. In contrast to claim 25, Levin teaches a system for conducting "promotional campaigns" which includes conducting "electronic survey, including creating, publishing, and collecting and analyzing data generated by the survey." (See Levin at paragraph [0058] and FIG. 1.) However, similar to Sakoda and Van Erlach, Levin fails to teach or suggests at least the claimed "selecting one of presenting the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time."

For at least these reasons, the pending claims are allowable over the proposed combinations.

#### CONCLUSION

The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence with other positions of the Examiner that have not been explicitly contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims. No fees are believed due. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: December 8, 2008

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